

REMARKS***Remaining Claims***

Eight (8) claims remain pending in this application. Applicants have amended independent claim 1 and added claim 48.

Oath/Declaration

A corrected oath and declaration will be submitted by separate correspondence.

Claim Rejections under 35 U.S.C §103

Claims 1-6 were rejected under 35 U.S.C. §103 (a) as being “unpatentable over Israel (U.S. Patent No. 6139145) in view of Zhang et al. (U.S. Patent No. 5997140.)” Claim 7 was rejected further in view of Chang.

Applicants have amended claim 1, from which claims 2-7 depend.

The two references cannot be combined to support an obviousness-type rejection because Israel must be modified to be combined with Zhang, which destroys the intended function of Israel. Israel, as stated in the RCE and Amendment filed on 09 June 2005 is designed to shift an image to a healthy portion of the retina (other than the fovea) to overcome macular degeneration. The present invention uses only one optical power at a time to form a clearly perceivable image along the wearer's line of sight, more specifically at the fovea.” (emphasis added). Forming a clearly perceivable image at the fovea destroys the intent of Israel, which moves an image away from the fovea. The CCPA and the Federal Circuit have consistently held that when a 103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such a proposed modification is not proper and the prima facie case cannot be properly made. *See, e.g., In re Gordon*, 733F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Altering Israel in such a way as to combine it with Zhang for the purpose of rendering the present application obvious would destroy the intent, purpose and function of Israel. As such, the combination of Israel and Zhang is improper.

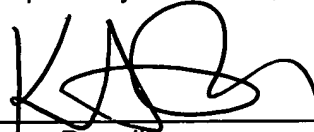
In summary, the combination of Israel with Zhang is improper because there is no teaching or suggestion to do so and such combination would destroy the intent, purpose and function of Israel.

CONCLUSION

For the foregoing reasons, Applicants submit that Claims 1-7 and 48 are patentable over the cited art. Applicant respectfully requests reconsideration and withdrawal of the claim rejections set forth in the Office Action and allowance of claims 1-7 and 48.

Should the Examiner believe that a discussion with Applicants' representative would further the prosecution of this application, the Examiner is respectfully invited to contact the undersigned. Please address all correspondence to Rob Gorman, CIBA Vision Patent Department, 11460 Johns Creek Parkway, Duluth, GA 30097. The Commissioner is hereby authorized to charge any other fees which may be required under 37 C.F.R. §§1.16 and 1.17, or credit any overpayment, to Deposit Account No. 50-2965.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'KB', is written over a horizontal line.

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